to display to the user and solicits selections from the user pertaining to images displayed. The user's selections are then incorporated into the posterior distribution via a probabilistic user model.

In summary, Cox et al. discloses a queryless multimedia database retrieval method and system that maintain a posterior probability distribution for use in selecting the next images to display to the user. However, Cox et al. does not disclose searching a media clip database that contains information describing each associated media clip in the media clip database in the form of keywords and find similar clips indicia having hidden criteria. Cox et al. also does not disclose that, in response to a user selecting a media clip, retrieving information associated with the selected media clip, including hidden criteria associated with find similar clips indicia and keywords, from the media clip database. Because Cox et al. does not retrieve such information from the database, Cox et al. cannot present such information to the user and, thus, does not enable the user to select search criteria based on such information, i.e., based on hidden criteria associated with find similar clips indicia and keywords. Furthermore, Cox et al. does not provide that, in response to the user selecting search criteria based on such information, retrieving all of the media clips in the media clip database that match the search criteria created by the user. Only the present invention teaches this subject matter.

Claims 1-9, 11-12, 13-32, 34, 35, and 37-44

As amended, Claim 1 reads as follows:

1.   A method for searching a media clip database associated with a multimedia application program, wherein said media clip database contains information, including keywords **and hidden criteria associated with find similar clips indicia**, that describes each associated media clip in said media clip database, comprising:
      (a)   in response to a user selecting a media clip, retrieving information, **including hidden criteria associated with find similar clips indicia** and keywords, associated with said selected media clip from said media clip database;
      (b)   **simultaneously presenting to the user for selection by the user:**
            (i)   said keywords associated with said media clips; and
            (ii)   **said find similar clips indicia having associated hidden criteria;** and
      (c)   in response to the user creating search by selecting one or more said keywords **and/or said find similar clips indicia** associated with said selected media clip, retrieving all media clips in said media clip database that match the search criteria created by the user. [Emphasis added.]

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Claim 1 clearly recites a method for searching a media clip database associated with the media application program wherein the media clip database contains information, including keywords and hidden criteria associated with find similar clips indicia, that describes each associated media clip in the media clip database. As noted above, Balogh et al. does not clearly teach the use of keywords. More importantly, Balogh et al. does not teach hidden criteria associated with find similar clips indicia. Nor, as more fully discussed below, does Cox et al. teach hidden criteria. Hidden criteria associated with find similar clips indicia are criteria associated with media clips that are not available or not displayed to a user. What is displayed to the user is indicia related to the criteria, such as color, shape, and artistic style.

Claim 1 goes on to recite that the method includes, in response to a user selecting a media clip, retrieving information, including hidden criteria associated with find similar clips indicia and keywords, associated with said selected media clip from the media clip database. The method further comprises simultaneously presenting to the user for selection by the user both keywords associated with the media clip and find similar clips indicia having associated hidden criteria. Balogh et al. does not teach or even remotely suggest presentation of both keywords and find similar clips indicia to a user for selection by the user. Nor does Cox et al. teach or suggest this subject matter. Claim 1 also recites, in response to the user creating search criteria by selecting one or more of said keywords and/or said find similar clips indicia associated with said selected media clip, retrieving all media clips in said media clip database that match the search criteria created by the user. Since Balogh et al. does not teach presenting keywords or find similar clips indicia, clearly, Balogh et al. does not disclose retrieving all media clips in a media clip database that match the search criteria created by the user based on a selection of one or more of the keywords and/or the find similar clips indicia. Nor does Cox et al. teach this subject matter.

With respect to Cox et al., as noted above, Cox et al. does not teach a system that includes hidden criteria associated with "find similar clips indicia" that describes each associated media clip in a media clip database suitable for selection by a user. What Cox et al. discloses is a system wherein a plurality of images, i.e., media clips, are displayed. When a user selects a displayed media clip, information about the media clip is analyzed. More specifically, each media clip has a feature set (Table 1, column 6) that defines the image. The features are weighted (Table 2, columns 7 and 8) and the result used to select other images. This is not the same as presenting find similar clips indicia associated with hidden criteria so that a user can create search criteria based on the find similar clips indicia presented to the user. **Cox et al. displays the stored media clip, not indicia about stored media clips**. Both the procedure and

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the end result are different. Consequently, even if the subject matter of Balogh et al. and Cox et al. were combinable, which applicants specifically deny, the resultant combination would still not anticipate the subject matter of Claim 1.

With respect to combining the teachings of Balogh et al. and Cox et al., applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness. In essence, the rejection uses hindsight reasoning based on the teachings of the present invention, not the teachings of the references, to reject Claim 1. This is clearly contrary to decisions of the Court of Appeals for the Federal Circuit (Fed. Cir.) and its predecessor court, the Court of Customs and Patent Appeals (C.C.P.A.), and the Board of Appeals. In this regard, attention is directed to the following quotations from Federal Circuit and C.C.P.A. cases:

> It should be too well settled now to require citation or discussion that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 U.S.P.Q. 209, 212 (C.C.P.A. 1971).
>
> <div align="center">*********</div>
>
> It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law. *Orthopedic Equipment, Inc. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).
>
> <div align="center">*********</div>
>
> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined <u>only</u> if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The *ACS Hospital Systems, Inc. v. Montefiore Hospital* decision has been cited with approval by the Federal Circuit. *See In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Similar statements have been made in many decisions of the Board of Appeals.

> Nor do we see any suggestion in either of the references which would lead anyone having ordinary skill in the art to combine the structure taught by either reference with that taught by the other.

> In order to justify a combination of references such as is here suggested it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so. Since the art does not suggest the use of either of the patented devices for ... there is nothing

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to indicate that one should be modified in view of the other for that purpose. *Ex parte Walker,* 135 U.S.P.Q. 195, 196 (Bd. App. 1962).

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We have studied the references and the manner in which the examiner proposes to combine their teachings but we are unable to find in these references any suggestion that they should or could be combined, absent appellant's disclosure in the present application. *Ex parte Lennox,* 144 U.S.P.Q. 224, 225 (Bd. App. 1964).

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While as an abstract proposition it might be possible to select features from the secondary references, as the examiner has done, and mechanically combine them with the Mallin device to arrive at appellant's claimed combination, we find absolutely no basis for making such combination neither disclosed nor suggested in the patents relied upon. <u>In our view only appellant's specification suggests any reasons for combining the features of the secondary references with the primary reference and under the provisions of 35 U.S.C. 103 that does not constitute a bar</u>. *Ex parte Fleischmann,* 157 U.S.P.Q. 155 (Bd. App. 1967). (Emphasis added.)

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In the instant application, the Office Action has done little more than cite references and attempt to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. First, the references do not even teach what the Office Action states that they purportedly teach Specifically, Cox et al. does not teach hidden criteria associated with "find similar clips indicia" that describes an associated media clip stored in a media clip database, much less displaying such find similar clips indicia. What Cox et al. discloses is displaying media clips. Displaying media clips is not the same as displaying find similar clips indicia. Further, even if the references disclose what the Office Action purports that they disclose, which applicants expressly deny, in order to support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Office Action must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp* , 227 U.S.P.Q. 972, 973 (Bd. App. 1985). This has not been done.

In conclusion, it is clear that neither Balogh et al. nor Cox et al. taken alone or in combination teaches or even remotely suggests the subject matter of Claim 1 taken as a whole. As a result, applicants respectfully submit that Claim 1 and all of the remaining claims in this

application that depend from Claim 1, namely, Claims 2-9, 11, 12, 14, and 15, are clearly allowable. Consequently, withdrawal of the rejection of these claims based on the teachings of Balogh et al. and Cox et al. and allowance of these claims is respectfully solicited.

Many of the claims depending from Claim 1 are submitted to be allowable for additional reasons. For example, Claims 6, 7, 8, and 9, all of which depend from Claim 1, recite specific hidden criteria, namely, artistic style, color, and shape. Clearly, this subject matter is not taught or even remotely suggested by Balogh et al. and/or Cox et al., particularly when considered in combination with the subject matter of Claim 1. As a result, applicants respectfully submit that these claims and other claims dependent upon Claim 1 are allowable for reasons in addition to the reasons why Claim 1 is allowable.

As amended, Claim 16 reads as follows:

> 16. A method for providing a user interface for a visual thesaurus for a media clip database associated with a multimedia application program, wherein said media clip database contains information, **including hidden criteria associated with find similar clips indicia** and keywords, that describes each associated media clip in said media clip database, comprising:
> directly in response to a user selecting a media clip from said media clip database, displaying to the user an option for finding similar media clips **that have an associated find similar clips indicia hidden criteria**, and/or a keyword that matches the find similar clips indicia hidden criteria, and/or keyword associated with the selected clip. [Emphasis added.]

Claim 16 is directed to a method for providing a user interface for a visual thesaurus for a media clip database associated with a multimedia application program. The media clip database is recited as containing information, including hidden criteria associated with find similar clips indicia in keywords, that describes each associated media clip in the database. The method is recited as, directly in response to a user selecting a media clip from the media clip database, displaying to the user an option for finding similar media clips that have an associated find similar clips indicia hidden criteria, and/or a keyword, that matches the find similar clips indicia hidden criteria, and/or keyword associated with the selected clip. As discussed above, clearly this subject matter is not taught or suggested by Balogh et al. or Cox et al. taken alone or in combination. While applicants disagree with the Office Action's position regarding Balogh et al.'s disclosure of keywords, even if correct, Balogh et al. clearly does not disclose hidden criteria associated with find similar clips indicia and displaying an option to a user to select a find similar media clips indicia that employs hidden criteria, and/or a keyword. Nor does Cox et al. teach or suggest this subject matter. Cox et al. does not teach or disclose an "option for

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finding similar clips that have an associated find similar clips indicia hidden" criteria. At best, Cox et al. discloses an option for finding similar clips that match a displayed media clip. As a result, applicants respectfully submit that Claim 16 and the claims dependent therefrom (Claims 17-23) are clearly allowable in view of the teachings of Balogh et al. and Cox et al. taken alone or in combination.

Claim 24, as amended, reads as follows:

24. An apparatus for searching a plurality of media clips, comprising:
(a) a processing unit; and
(b) a storage medium coupled to the processing unit, the storage medium storing program code implemented by the processing unit for:
(i) providing an interface for a user to select a media clip from a media clip database associated with a multimedia application program, wherein said media clip database contains information, **including hidden criteria associated with find similar clips indicia** and keywords, that describes each associated media clip in said media clip database;
(ii) providing an interface for the user to select search criteria based on **find similar clips indicia hidden criteria** and/or a keyword associated with said selected media clip; and
(iii) in response to the user selecting the media clip and the search criteria, retrieving all media clips in the media clip database that have associated **find similar clips indicia hidden criteria**, and/or a keyword that matches the selected search criteria for the selected media clip. [Emphasis added.]

Claim 24 is clearly directed to an apparatus for searching a plurality of media clips comprising a processing unit and a storage medium coupled to the processing unit. The storage medium stores program code implemented by the processing unit for providing an interface for a user to select a media clip from a media clip database associated with a multimedia application program, the media clip database containing information, including hidden criteria associated with find similar clips indicia and keywords, that describes each associated media clip in the media clip database. The program code also provides an interface for the user to select search criteria based on find similar clips indicia and/or a keyword associated with the selected media clip. The program code further provides, in response to the user selecting a media clip and the search criteria, retrieving all media clips in the media clip database that have associated find similar clips indicia hidden criteria, and/or a keyword that matches a selected search criteria for the selected media clip. As discussed above with respect to Claims 1 and 16, the use of keywords is not taught or suggested by Balogh et al. or Cox et al. Even if the Office Action's

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position regarding Balogh et al.'s disclosure of keywords is correct, which applicants specifically deny, clearly neither Balogh et al. nor Cox et al. teaches a clip database that contains information including hidden criteria associated with find similar clips indicia, much less use find similar clips indicia to retrieve media clips based on the associated hidden criteria. As a result, applicants respectfully submit that Claim 24 and all the claims dependent therefrom remaining in this application (Claims 25-32, 34, 35, and 37) are clearly allowable. Applicants further submit that many of these dependent claims, when considered in combination with the subject matter of the claims from which these claims depend, are also allowable for additional reasons. For example, neither Balogh et al. nor Cox et al. teach the subject matter of Claims 29-32.

Claim 38, as amended, reads as follows:

38. An apparatus for providing a user interface for a visual thesaurus for a media clip database associated with a multimedia application program, wherein the media clip database contains information, **including hidden criteria associated with find similar clips indicia** and keywords, that describes each associated media clip in said media clip database, comprising:
(a) a processing unit; and
(b) a storage medium coupled to the processing unit, the storage medium storing program code implemented by the processing unit **for displaying to a user an option for finding similar media clips that have associated find similar clips indicia hidden criteria**, and/or a keyword that matches an associated keyword for a selected media clip, directly in response to the user selecting the media clip. [Emphasis added.]

Claim 38, like Claim 16, is directed to providing a user interface for a visual thesaurus for a media clip database associated with multimedia programs, albeit in apparatus rather than method form. Claim 38 specifically recites that the media clip database contains information, including hidden criteria associated with find similar clips indicia and keywords, that describes each associated media clip in the media clip database. The apparatus is recited as comprising a processing unit and a storage medium coupled to the processing unit. The storage medium is recited as storing program code implemented by the processing unit for displaying to a user an option for finding similar media clips that have associated find similar clips indicia hidden criteria and/or a keyword that matches an associated keyword for a selected media clip, directly in response to the user selecting a media clip. This subject matter is not taught or suggested by Balogh et al. or Cox et al. Regardless of the correctness of the Office Action's position regarding Balogh et al.'s teaching of the use of keywords, which applicants specifically deny, clearly neither Balogh et al. nor Cox et al. teaches hidden criteria associated with find similar clips